



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,601	01/30/2001	Thomas W. Poplawski	P/2167-247	1711

7590 11/17/2004

MICHAEL J. SCHEER
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
1177 AVENUE OF THE AMERICA, 41 ST FLOOR
NEW YORK,, NY 10036-2714

EXAMINER

FELTEN, DANIEL S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,601

Applicant(s)

POPLAWSKI ET AL.

Examiner

Daniel S Felten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Examiner's Note

The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations with the individual claims, other passages and figures apply as well. It is requested from the Applicant in preparing a response to consider the entire references in full as well as the context of all references passages as potentially teaching all or part of the claimed inventions.

Status of Claims

1. Receipt of the Amendment in Response to the Non-Final Office Action filed July 30, 2004 is acknowledged. Claims 1-32 are pending in the application and are presented to be examined upon their merits.

Response to Arguments

2. Applicant's arguments (see Remarks, filed July 30, 2004) with respect to the rejection(s) of claim(s) 1-32 under Schultzer (US 6,292,789) in view of Hilt (US 5,465,206) and in further view of O'Leary (US 6,609,113) have been fully considered and are persuasive. Therefore, the rejection using O'Leary has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the prior art presented in the following rejections below:

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 6-9, 17-19, 24-26 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haseltine et al (US 6,578,015) in view of Hogan (US 5,599, 528).

Re Claim 1:

Haseltine discloses a method for effectuating bill presentment and payment comprising:

maintaining a billing database (400), the billing database (400) containing detailed billing information (402, 404) with respect to at least one bill, the at least one bill reflecting an account of at least one payer with respect to at least one biller (see Haseltine, Abstract; col. 5, ll. 12-18) ;

generating an electronic summary (402) of the at least one bill using the detailed billing information, the electronic summary being formatted in the form of a remittance slip (*traditional paper bill*) that would be traditionally associated with a paper based bill (see Haseltine, col. 5, ll. 12-18+);

generating an electronic notification with respect to the at least one bill, the electronic notification containing the electronic summary and an address through which the billing database may be accessed (see Haseltine, col. 7, ll. 34-47); and

transmitting the electronic notification to the at least payer , (see Haseltine, col. 7, II. 34-47),

Haseltine fails to disclose wherein the electronic summary can be printed out to serve as a the remittance slip in a traditional method of payment of the at least one bill by the at least one payers whereby the at least one payer retains control of the bill payment process by the traditional method.

Hogan discloses a method for bill delivery and payment over the Internet wherein the electronic summary/bill can be printed out to serve as a the remittance slip in a traditional method of payment of the at least one bill by the at least one payers whereby the at least one payer retains control of the bill payment process by the traditional method (see Hogan, Abstract; and col. 5, II. 1-15). The ability to print text and images from an Internet website that is displayed on a computer screen is notoriously old and well known with the computer networking art. Thus to modify Haseltine with the ability to print personal billing information from an Internet website, as taught by Hogan, would be considered an obvious expedient well within the ordinary skill in the art because an artisan would recognize the fact that users may prefer/require printed copies as backup of their electronic files in the event that the electronic file(s) and/or database becomes corrupted, compromised and/or lost. Thus an artisan of ordinary skill in the art at the time of the invention would have been motivated to modify Haseltine with Hogan's teachings to have an alternative to viewing the bills and so that the users can feel more secure with using an online billing/payment system. Thus such a convenience would have been an obvious expedient well within the ordinary skill in the art.

Re claim 2:

Haseltine discloses maintaining an Internet site, wherein the billing database containing the detailed billing information is maintained on the Internet site (see Haseltine, col. 9, ll. 51+).

Re claim 3:

Haseltine discloses wherein the Internet site is maintained by the at least one biller (see Haseltine, col. 9, ll. 51+).

Re claim 6:

Haseltine discloses wherein address through which the billing database may be accessed is a Uniform Resource Locator (URL) address of the Internet site, the method further comprising:

providing the at least one payer with access to the Internet site through the URL; and authenticating the at least one payer at the Internet site (see Haseltine, col. 11, ll. 5-30) .

Re claim 7:

Haseltine discloses allowing the at least one payer with the opportunity to pay the bill electronically on the Internet site (see Haseltine, col. 10, ll. 5-11).

Re claim 8:

Haseltine discloses wherein the electronic notification is an e-mail message (see Haseltine, col. 7, ll. 34-47).

Re claim 9:

Haseltine discloses wherein the step of authenticating the at least one payer requiring the at least one payer to enter a unique username and password (see Haseltine, col. 9, ll. 16+).

Re claim 17:

Haseltine discloses wherein the electronic summary information contains at least a name of the at least one biller, a statement date, a minimum amount due, a total amount due and a due date (see Haseltine, col. 8, ll. 8+).

Re claim 18:

Haseltine discloses registering the at least one payer with the at least one biller with respect to receiving the electronic notification of the present invention (Haseltine, col. 7, ll. 34+).

Re claim 19:

Haseltine discloses a method for effectuating electronic bill presentment and payment comprising the steps of:

maintaining a billing database the billing database containing detailed billing information with respect to at least one payer of the at least one biller (see Haseltine, Abstract; col. 5, ll. 12-18);

maintaining an electronic site wherein the at least one payer can view the electronic site, the electronic site containing a display of the detailed billing information (see col. 9, ll. 51+);

authenticating the at least one payer before allowing the at least one payer access to the display of detailed billing information (see Haseltine, col. 9, ll. 16+);

generating an e-mail containing summary information regarding a bill owed by the at least one payer to the at least one biller which is formatted as a remittance slip that would be traditionally associated with a paper based bill (see Haseltine, col. 7, ll. 34-47); and

transmitting the e-mail to the payer wherein the summary information can be printed out to serve as the remittance slip in a traditional method of payment of the bill by the at least one payers whereby the at least one payer retains control of the bill payment process by the traditional method (see explanation for claim 1 in view of Hogan).

Art Unit: 3624

Haseltine fails to disclose registering at least one biller with a service provider. Hogan discloses registering at least one biller with a service provider (*electronic bill service company, "EBSC"*) (see Hogan, col. 4, ll. 36+; and col. 5, ll. 44+) It would have been obvious for one of ordinary skill in the art at the time the invention was made to

Re claim 24:

Haseltine discloses a system for effectuating bill presentment and payment, the system comprising:

a billing database (400), the billing database continuing detailed billing information with respect to at least one bill, the at least one bill reflecting an account of at least one payer with respect to at least one biller (see Haseltine, Abstract; col. 5, ll. 12-18);

a processor (702 with logic—630) coupled to the billing database, the processor (see Haseltine, figs. 6, 7, col. 11, ll. 63 to col. 13, ll. 40):

generating an electronic summary of the at least one bill using detailed billing information, the electronic summary being formatted in the form of a remittance slip that would be traditionally associated with a paper based bill, generating an electronic notification containing the electronic summary and containing an address through which the billing database may be accessed; and

a communication network coupled to the processor, the processor transmitting the electronic notification to the at least payer over the communication network, wherein the electronic summary can be printed out to serve as the remittance slip in a traditional method of payment of the at least one bill by the at least one payer. whereby the at least one payer retains control of the bill payment process by the traditional method.

Re claim 25:

(see citation for claim 2)

Re claim 26:

(see citation for claim 3)

Re claim 29:

(see citation for claim 6)

Re claim 30:

(see citation for claim 7)

Re claim 31:

(see citation for claim 8)

Application/Control Number: 09/772,601
Art Unit: 3624

Page 10

Re claim 32:

(see citation for claim 9)

5. Claims 4, 5, 10-16, 20-23, 27 and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Haseltine et al (US 6,578,015) as modified by Hogan (US 5,599, 528) as applied to claim 1 as discussed above, and further in view of Schutzer (US 6,292,789) and Hilt et al (US 5,465,206). The teachings of Haseltine as modified by Hogan have been discussed above.

Re claims 4, 5, 14, 20, 21, 27, 28:

Haseltine as modified by Hogan fail to teach of fairly suggest, as wherein the Internet site is maintained by a Billing Service Provider (BSP) the BSP performing billing services for the at least one biller; and as in claim 5, wherein the Internet site is maintained by a Customer Service Provider (CSP) the CSP performing billing services for the at least one biller.

Schutzer discloses wherein the Internet site is maintained by a Billing Service Provider (BSP) the BSP performing billing services for the at least one biller (see Schutzer, fig. 7, col. 11, ll. 33-64); as in claim 5, wherein the Internet site is maintained by a Customer Service Provider (CSP) the CSP performing billing services for the at least one biller (see Schutzer, fig. 7, col. 11, ll. 33-64 and col. 14, ll. 26+).

In view of Schutzer, it would have been obvious for an artisan at the time of the invention was made to employ the teachings of Schutzer to the teachings of Haseltine as modified by Hogan because an artisan at the time of the invention would recognize the features disclosed in Schutzer were an obvious extension of the electronic bill

Art Unit: 3624

service company ("EBSC") disclosed in Hogan for the motivations enunciated by Hogan (see col. 4, ll. 36-43). Thus such a modification would have been considered substitution of functional equivalence and/or providing the latest technology in the bill presentment art. Thus such a modification would have been considered an obvious expedient well within the ordinary skill in the art.

Re claim 10:

registering the at least one biller with a billing service provider (BSP), wherein the BSP interfaces with the at least one biller with respect to the presentment of the at least one bill; and registering the at least one payer with a customer service provider (CSP), wherein the CSP interfaces with the at least one payer with respect to the payment of the at least one bill (see Schutzer, figs. 8 and col. 15, ll. 39 to col. 16, ll. 44).

Re claims 11, 12, 13, 22, 23 :

Haseltine as modified by Hogan fail to teach or fairly suggest wherein the BSP and CSP are the same entity; wherein the BSP and/or the CSP is a bank. Hilt teaches that the BSP and CSP are the same entity and wherein the BSP and/or the CSP is a bank (16 and 18) (see Hilt, figs. 4, 6, 7, Abstract. Col. 12, ll. 41+; col. 16, ll. 4+; and col. 17, ll. 46+). The motivation to combine the Hilt reference with Haseltine, Hogan and Schutzer would be to overcome shortcomings in the prior art expressed by Hogan in the prior art (see figs. 1-3, starting in col. 4, ll. 7 to col. 10, ll. 29) wherein Haseltine, Hogan and Schutzer are presented as various systems within the Electronic Bill Payment and

Art Unit: 3624

presentment art. Thus such a modification would constitute an obvious expedient well within the ordinary skill in the art.

Re claim 15:

wherein the step of transmitting the detailed billing information further comprises:
transmitting the detailed billing information as a bulk file containing all of the detailed billing information for a specified period of time (see Haseltine, Abstract; col. 5, ll. 12-18).

Re claim 16:

wherein the specified period of time is one month (see Haseltine, Abstract; col. 5, ll. 12-18).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patents:

Lamm (US 6,078,907) method and system for electronically presenting and paying bills

Dent et al (US 6,128,603) consumer-based system and method for managing and paying electronic billing statements

Kolling et al (US 6,385,595) electronic statement presentment system

Ganesan (US 6,678,664) discloses cashless transactions without credit cards debit cards or checks

US Patent Publications:

Saliba et al (US 2002/0065772 A1) system and method and program for network user access.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF
November 4, 2004

Daniel S Felten
Examiner
Art Unit 3624



**VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**